REMARKS

Claims **1-20** are pending. By this amendment, claims **1**, **6**, and **17** are amended for the Examiner's consideration. The amendments to the claims should be entered because they do not raise new issues that need further search and/or consideration. Specifically, the recitation of the language "specify" was already considered with reference to previously presented claim 13. Reconsideration and timely withdrawal of the pending rejections are requested for the reasons discussed below.

35 U.S.C. § 102 Rejection

Claims **1-6, 13-18**, and **20** are rejected under 35 U.S.C. § 102(b) as being allegedly anticipated by U. S. Patent No. 5,867,110 issued to Naito, *et al.* ("Naito"). This rejection is respectfully traversed.

A rejection under 35 U.S.C. § 102(b) requires that a single prior art reference disclose each and every feature of the claimed invention. Accordingly, a claim is allowable if it recites at least one novel element not disclosed in the cited reference. In this case, claims 1-6, 13-18, and 20 are allowable over Naito because they each recite at least one feature that Naito does not teach.

Independent claim 1 recites, in pertinent part:

> ... a portable terminal machine configured to specify the object to
> be managed, among a plurality of objects to be managed ...

Similarly, independent claim 13 recites, in pertinent part:

> ... prompting a user to specify a specific object to be managed from
> among the plurality of objects to be managed ...

Claim 6 also recites the portable terminal machine to specify the position information of a particular object of the objects to be managed.

In contrast, Naito specifically teaches that its portable display unit does not specify any object to be managed from among a plurality of objects to be managed. Instead, a satellite GPS system automatically communicates position data indicative of the portable display unit's position directly to the portable display unit itself. In turn, the portable display unit automatically relays this position data to a host server. Upon receipt of the portable display unit's position data, the host server processes the position data to determine what area the portable display unit is in, and uses the processed position data to retrieve predetermined weather, road, and emergency data from a database. Because the retrieved data is based on the portable display unit's position, it corresponds to or identifies real-time events occurring in the portable display unit's geographical area. However, Naito's system neither provides a portable terminal machine that specifies an object to be managed, among a plurality of objects to be managed, nor prompts a user to specify a specific object to be managed from among the plurality of objects to be managed.

Claim 1 further recites, in pertinent part:

> ... wherein the portable terminal machine displays a position of the object to be managed according to position data in the database transferred from the host computer to the portable terminal machine ...

Claim 13, similarly further recites, in pertinent part:

> ... displaying the position of the specific object to be managed in the area on the map according to the map data and the position data read from the database ...

Additionally, independent claim 17 similarly recites, in pertinent part:

... a second process for drawing on the map a display mark of the
object to be managed according to an input from a user that
specifies the object to be managed from among a plurality of
objects to be managed ...

Claim 6 also recites a map display unit for displaying a position where the particular object is

located on a map according to the position information

In contrast, Naito discloses receiving the portable display unit's position data and

processing that data to retrieve predetermined map, weather, and emergency data from a

database connected to the host server. This is contrary the invention recited by claim 1 which

displays a position of an object to be managed according to position data in a database

transferred from a host computer to the portable terminal machine. It is also contrary the

invention recited by claim 13, which displays the position of the specific object to be managed

on a map according to map data and position data read from the database. It is further contrary

the invention recited by claim 17, which draws on a map a display mark of the object to be

managed based on an input from a user that specifies the object to be managed from among a

plurality of objects to be managed. Similarly, this is contrary to claim 6.

For these reasons, claims 1, 6, 13, and 17 are allowable over Naito, and thus are in

condition for allowance. Claims 2-5 depend on allowable claim 1; claims 14-16 and 20 depend

from allowable claim 13; and claim 18 depends from allowable claim 17. Consequently,

dependent claims 2-5, 14-16, 18, and 20 are allowable over Naito for the same above reasons as

independent claims 1, 13, and 17, as well as for their own added features. Withdrawal of the 35

U.S.C. § 102(b) rejection, and allowance, of claims 1-6, 13-18, and 20 is requested.

35 U.S.C. § 103 Rejection

Claims **7-12** and **19** are rejected under 35 U.S.C. § 103(a) as being unpatentable over

U.S. Patent No. 5,867,110 issued to Naito, *et al.* ("Naito"). This rejection is respectfully

traversed.

Applicants note that a rejection under 35 U.S.C. § 103(a) requires the Examiner to first

establish a prima facie case of obviousness: "The examiner bears the initial burden of factually

supporting any prima facie conclusion of obviousness. If the examiner does not produce a prima

facie case, the applicant is under no obligation to submit evidence of nonobviousness." M.P.E.P.

§ 2142. The Court of Appeals for the Federal Circuit has set forth three elements which must be

shown for prima facie obviousness:

> First, there must be some suggestion or motivation, either in the
> references themselves or in the knowledge generally available to
> one of ordinary skill in the art, to modify the reference or to
> combine reference teachings. Second, there must be a reasonable
> expectation of success. Finally, the prior art reference (or
> references when combined) must teach or suggest all the claim
> limitations. The teaching or suggestion to make the claimed
> combination and the reasonable expectation of success must both
> be found in the prior art, and not based on applicant's disclosure.
> *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Claims 7 and 19

As previously mentioned, the Examiner admits that Naito does not disclose "... to identify

position data of the object to be managed independent of the portable position display apparatus'

position." This feature is explicitly recited by claim 7. However, in making the rejection under

35 U.S.C. § 103(a), the Examiner cites no secondary reference to cure this deficiency. Instead,

the Examiner proposes that:

> It would have been obvious to a person of ordinary skill in the art
> to modify the teachings of Naito with managed (objects)
> independent of the portable position. Such motivation would allow
> the teachings of Naito to provide an information reporting system
> which allows a user of a portable terminal to obtain information
> regarding circumstances at his or her current position (See, col. 1,
> lines 59-62).

Respectfully, the Examiner's propositions appear to be inaccurate and contrary to the plain

teachings of Naito.

The Examiner distinguishes Applicants' claims by stating:

> Such motivation would allow the teachings of Naito to provide an
> information reporting system *which allows a user of a portable*
> *terminal to obtain information regarding circumstances at his or*
> *her current position.* (emphasis added).

This passage distinguishes Applicants' claims because claim 7 specifically recites that position

data (not data regarding circumstances existing at a particular location) of an object to be

managed is retrieved independent of the portable terminal machine's position. In other words,

the retrieved position data does not correspond to a location of the claimed portable terminal

machine, but rather corresponds to a location of an object to be managed that was specified by a

user from among a plurality of objects to be managed. For these reasons, claim 7 is

distinguishable over Naito, and in condition for allowance.

Similar to claim 7, claim 19 recites, in pertinent part:

> ... wherein the portable terminal machine is configured to input
> object information for managing the object to be managed
> independent of the position of the portable terminal and the object
> to be managed.

In contrast, as discussed above, Naito's system is dependent on the position of its portable display unit. The claimed invention recited in claim 19, on the other hand, includes a portable terminal machine that inputs object information for managing an object to be managed that is independent of the portable terminal machine's position. For this reason, claim 19 is allowable over Naito.

Claims 8-12

Also rejected were claims 8 and 9, the elements of which, the Examiner suggested were disclosed by Naito. Claim 8, recites:

> The apparatus of claim 7, further including a data receiving unit for
> receiving the database.

Similarly, claim 9 recites:

> The apparatus of claim 7, further including a management
> information display unit for displaying management information of
> the object to be managed according to the attribute data in the
> database when the searching unit identifies the match.

In contrast to claim 8, Naito does not disclose that its database is transferable, at least not between the host server and the portable display unit. Rather, the host server accesses the database, retrieves necessary information, and then transmits this retrieved information to a remote portable display unit. The claimed invention, on the other hand, transfers an entire database of predetermined attribute and position information to a data receiving unit, which in one embodiment is a portable terminal machine. For this reason, claim 8 is allowable over Naito.

In contrast to claim 9, Naito does not disclose displaying management information about one of a plurality of objects to be managed according to that attribute data in the database when the searching unit identifies the match. Instead, Naito's portable terminal machine transmits its real-time position information to the host server, which processes the information to retrieve from a database predetermined information that corresponds to the position currently occupied by the portable display unit. For this reason, claim 9 is allowable over Naito.

Claim 11 recites, in pertinent part:

> ... a mark drawing unit for enabling a user to draw a display mark on the map displayed by the map display unit;
>
> a coordinate obtaining unit for obtaining coordinates of the display mark drawn by the mark drawing unit; and
>
> a data storing unit for storing the coordinate data in the database as the position data of the display mark.

In contrast, nothing in Naito discloses that its portable terminal machine includes a mark drawing unit for enabling a user to draw a display mark on the map displayed by the map display unit. Instead, Naito teaches that the map data retrieved from a database based on a position of the portable display unit is simply displayed for the user to see. The user is not able to mark the map as recited in claim 11.

Similar to claim 11, claim 12 recites in pertinent part:

> wherein the map display unit, when the display mark is drawn by the mark drawing unit, displays a reference line created on the map in response to a fixed item in the area in which the object to be managed is positioned.

In contrast, nothing in Naito discloses this claimed feature. For example, the portable display unit disclosed by Naito does not display a reference line created on the map in response to a fixed item

in the area in which the object to be managed is positioned. Instead, as disclosed at col. 9, lines 50-54, Naito's communication host apparatus refers to the retrieval key table in the database to determine the longitude and latitude ranges defining an area in which the position corresponding to the received position information data falls. However, referencing a key table to determine longitude and latitude ranges is not the same as displaying a reference line on a map as claimed. Consequently, claim 12 is allowable over Naito.

Applicants respectfully request that the rejection of claims 7-12 and 19 be withdrawn, and that these claims be passed to issue.
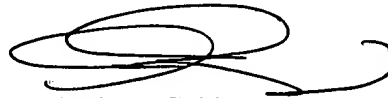
CONCLUSION

In view of the foregoing amendments and remarks, Applicants submit that all of the claims are patentably distinct from the prior art of record and are in condition for allowance. The Examiner is respectfully requested to pass the above application to issue. The Examiner is invited to contact the undersigned at the telephone number listed below, if needed. Applicants hereby make a written conditional petition for extension of time, if required. Please charge any deficiencies in fees and credit any overpayment of fees to **IBM Deposit Account 09-0457** (Endicott).

Respectfully submitted,

Andrew Calderon
Reg. No. 38,093

McGuireWoods LLP
1750 Tysons Boulevard
Suite 1800
McLean, VA 22102-4215
Tel: 703-712-5426
Fax: 703-712-5285

00240317US

\\COM\433619.4